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Reston, VA 20191

EXAMINER

O'CONNOR, GERALD J

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 20070904

Application Number: 09/303,368
Filing Date: April 30, 1999
Appellant(s): Bright et al.

MAILED

SEP 17 2007

GROUP 3600

Andrew M. Calderon
(Reg. No. 38,093)
For Appellant

EXAMINER'S ANSWER

This examiner's answer has been prepared in response to appellant's brief on appeal
filed July 19, 2006.

(1) *Real Party in Interest*

A statement identifying by name the real party in interest is contained in the brief.

(International Business Machines Corporation)

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. (Previous appeal and affirmance in the instant matter, Appeal No. 2003-0901.)

(3) *Status of Claims*

The statement of the status of claims contained in the brief is correct.

(Claims 1, 3, 4, 6, 8, 9, 11, 13-15, and 25-31 are pending, rejected, and appealed.)

(Claims 2, 5, 7, 10, 12, and 16-24 have been cancelled.)

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct. (None.)

(5) *Summary of Claimed Subject Matter*

The summary of claimed subject matter contained in the brief is correct.

(6) *Grounds of Rejection to be Reviewed on Appeal*

The appellant's statement of the grounds of rejection to be reviewed on appeal contained in the brief is correct:

- I. Claims 1, 3, 4, 6, 8, 9, 11, 13-15, and 25-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al. (US 6,023,683).

(7) *Claims Appendix*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) *Evidence Relied Upon*

The following is a listing of the evidence (e.g., patents, publications, official notice, and admitted prior art) relied upon in the rejection of claims under appeal:

US 6,023,683

Johnson et al.

2/2000

(9) *Grounds of Rejection*

- I. Claims 1, 3, 4, 6, 8, 9, 11, 13-15, and 25-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al. (US 6,023,683).

Johnson et al. clearly anticipates all of the substantive elements of the instant invention, except that the system of Johnson et al. is an integrated, unitary system, performing all

necessary processing steps/functions, whereas the system contemplated by the instant invention, while performing exactly the same steps/functions overall, merely splits the various processing steps/functions out into two separate processing systems, a "pre-processor" and a "processor."

Thus, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Johnson et al., so as to split the processing steps/functions out into two separate modules or processing systems, a "pre-processor" and a "processor," in order to improve overall system performance/throughput, since it is well settled that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

Regarding claim 31, Johnson et al. do not specifically teach splitting the electronic sales order into at least two separate requests prior to transmitting to the order processing system. However, splitting an electronic order into two separate requests is certainly a well known, hence obvious, step to follow on processing an electronic order. For example, when an electronic order is placed for two different items, one of which is in stock and one of which is not in stock, the electronic order is typically split into two requests, one for immediate fulfillment and one as a backorder for later fulfillment when the unavailable item later becomes available, the credit card of the customer being charged two times, one time for the first request (first half of the split order) at the time of fulfillment of the first request, then later for the second request (second half of the split order) at the later time of fulfillment of the second request.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Johnson et al. so as to split the electronic sales order into at least two separate requests prior to transmitting to the order processing system, as is well known to do, in order to allow items in stock to be fulfilled immediately and the credit card of the customer charged immediately for those items being fulfilled immediately, and to allow the items not in stock to be backordered for later fulfillment when the unavailable items become available, with the credit card of the customer then being charged at that later time for those items being later fulfilled, so as to expedite sales of available items while maintaining customer satisfaction by not charging the customer in advance for unavailable items, since so-doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

(10) *Response to Argument*

I. Claims 1, 3, 4, 6, 8, 9, 11, 13-15, and 25-31 are unpatentable under 35 U.S.C. 103(a) for being obvious over Johnson et al. (US 6,023,683).

A. Regarding the argument that the system of Johnson et al. fails to perform error checking and correcting, the system of Johnson et al. indeed performs error checking and correcting. See, in particular, column 15, lines 10-19.

B. Regarding the argument that the system of Johnson et al. fails to include any human interaction other than by the user, the system of Johnson et al. indeed includes human interaction by the user and by the customer service representative that operates the workbench console to make corrections/changes as needed to the orders being prepared for processing.

C. Regarding the argument that splitting the order into two separate requests/orders prior to transmitting the order to the order processing system is not well known, such functionality is indeed well known, and, in any event, the system of Johnson et al. performs such functionality, splitting the order into two separate requests/orders prior to transmitting the order to the order processing system. See, in particular, column 15, lines 52-54, and column 17, lines 44-47.

D. Regarding the argument that no proper interpretation of Johnson discloses or suggests an order interceptor that is capable of adding, changing, or deleting electronic sales order data, wherein changes to an electronic sales order are logged, Johnson et al. indeed disclose or suggest an order interceptor that is capable of adding, changing, or deleting electronic sales order data, wherein changes to an electronic sales order are logged. See, in particular, column 15, lines 60-62).

E. In response to applicant's argument that the references applied in the rejection fail to use the same names for certain elements as the names used by applicant (i.e. "pre-processing" and "processing" versus "processing"), the argument is irrelevant, as it is noted that the disclosure in a reference must show the claimed elements arranged in the same manner as in the claims, but need not be in the identical words as used in the claims in order to be anticipatory. See *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

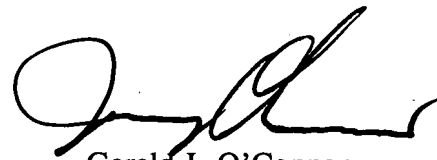
F. For further detailed rebuttal and discussion of applicant's arguments, attention is directed to the previous Examiner's Answer and to the Decision on Appeal, both incorporated herein by reference.

(11) *Related Proceeding(s) Appendix*

Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner's answer are contained in the brief.

For all of the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,



Gerald J. O'Connor
Primary Examiner
Group Art Unit 3627 9/4/07

GJOC

September 4, 2007

Appeal Conference Held:

F. Ryan Zeender 
Supervisory Patent Examiner
Group Art Unit 3627

Vincent Millin 
Supervisory Patent Examiner
Appeal Conference Specialist
Technology Center 3600

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